

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed November 1, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph**

Claim 12 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In response to the rejection, Applicant has amended claim 12 to recite a “star-shaped recess” instead of a “Torx head”. In view of that amendment, it is respectfully asserted that claim 12 defines the invention in the manner required by 35 U.S.C. § 112. Accordingly, Applicant respectfully requests that the rejection to be withdrawn.

### **II. Claim Rejections - 35 U.S.C. § 102(b)**

#### **1. Rejections Under Sihon**

Claims 1-8, 29 and 30 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sihon (U.S. Pat. No. 5,397,206). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore,

every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

Sihon discloses a vibration isolating fastener for “attaching a thin walled and apertured member such as a valve cover to another member such as an engine cylinder head.” Sihon, column 1, lines 6-11. Included with the fastener is a head portion 24, a shank portion 22 extending from the head portion, a rubber grommet member 28, and a sleeve member 26 that is positioned between the grommet member and the shank portion. Sihon, column 2, lines 27-40.

Applicant’s claim 1 provides as follows (emphasis added):

1. A fastener, comprising:  
an integrated isolation member composed of a resilient material,  
the isolation member being *adapted to isolate a storage media drive to which the fastener is to be mounted from a drive cage in which the drive is to be installed*, the isolation member being *sized and configured to fit within a slot of the drive cage and to abut a surface of the drive cage*.

Regarding claim 1, Sihon does not teach a fastener that is “adapted to isolate a storage media drive to which the fastener is to be mounted from a drive cage in which the drive is to be installed”. As is described above, Sihon’s fastener is for attaching a valve cover to an engine cylinder head. Applicant notes that the “adapted” limitation must be considered as it recites a physical constraint rather than a mere intended use by requiring that the fastener is “adapted” to isolate a drive from a drive cage. Sihon’s fastener is clearly not adapted for such an application.

Sihon's fastener also is not "sized and configured to fit within a slot of the drive cage and to abut a surface of the drive cage". Again, Sihon's fastener is not adapted for isolating a drive from a drive cage. Furthermore, nothing in Sihon's disclosure states that the Sihon fastener is "sized and configured" to fit within a slot of a drive cage, or any "slot" for that matter. Moreover, Sihon's disclosure fails to state that the Sihon fastener is "sized and configured" to abut a surface of a drive cage. First, Applicant asserts that those limitations, as the "adapted" limitation discussed above, recite a physical constraint as opposed to a mere intended use. Second, the argument that Sihon's fastener is "capable" of fitting within a slot of a drive cage and abutting a drive cage surface does not equate to the fastener being "sized and configured for" such applications. Third, there is nothing in Sihon's disclosure that actually states that Sihon's fastener is in fact capable of fitting within a slot of a drive cage or abutting a drive cage surface.

In view of at least the above, Applicant respectfully submits that Sihon does not anticipate claim 1 or its dependents and requests that the rejections be withdrawn.

## **2. Rejections Under Antoine**

Antoine, like Sihon, discloses a vibration isolating fastener for attaching a valve cover to an engine cylinder head. Antoine, column 1, lines 7-12. Included with the fastener is a head 14, a shank 18 extending from the head, a grommet 42, and a sleeve 28 that is positioned between the grommet and the shank. Antoine, column 2, lines 20-47.

Regarding claim 1, Antoine does not teach a fastener that is "adapted to isolate a storage media drive to which the fastener is to be mounted from a drive cage in which the drive is to be installed". As is described above, Antoine's fastener is for attaching a valve

cover to an engine cylinder head. Applicant notes that the “adapted” limitation must be considered as it recites a physical constraint rather than a mere intended use by requiring that the fastener is “adapted” to isolate a drive from a drive cage. Antoine’s fastener is clearly not adapted for such an application.

Antoine’s fastener also is not “sized and configured to fit within a slot of the drive cage and to abut a surface of the drive cage”. Again, Antoine’s fastener is not adapted for isolating a drive from a drive cage. Furthermore, nothing in Antoine’s disclosure states that the Antoine fastener is “sized and configured” to fit within a slot of a drive cage, or any “slot” for that matter. Moreover, Antoine’s disclosure fails to state that the Antoine fastener is “sized and configured” to abut a surface of a drive cage. First, Applicant asserts that those limitations, as the “adapted” limitation discussed above, recite a physical constraint as opposed to a mere intended use. Second, the argument that Antoine’s fastener is “capable” of fitting within a slot of a drive cage and abutting a drive cage surface does not equate to the fastener being “sized and configured for” such applications. Third, there is nothing in Antoine’s disclosure that actually states that Antoine’s fastener is in fact capable of fitting within a slot of a drive cage or abutting a drive cage surface.

In view of at least the above, Applicant respectfully submits that Antoine does not anticipate claim 1 or its dependents and requests that the rejections be withdrawn.

### **3. Rejections Under Lin**

Lin, discloses a fixing device for securing a data storage apparatus in a mounting bracket that is, in turn, attached to a computer enclosure. Lin, Abstract; column 1, lines 16-

20. Included with the fixing device is a screw 10, a grounding plate 20, and a spring gasket
30. Lin, column 2, lines 19-21.

Regarding claim 1, Lin does not teach a fastener that is “adapted to isolate a storage media drive to which the fastener is to be mounted from a drive cage in which the drive is to be installed”. As is described above, Lin’s fastener is for securing a data storage apparatus *in a mounting bracket*, which is then attached to a computer enclosure. Even if one were to assume that Lin’s “computer enclosure” was a “drive cage”, Lin’s fastener would not isolate the data storage apparatus *from the drive cage* because, as is clearly shown in Lin’s Figure 3, Lin’s faster cannot serve that purpose. Specifically, Lin’s “spring gasket” is sandwiched between the mounting bracket 42 and the head of the fastener 1. Accordingly, it cannot be said that Lin’s fastener is “adapted” to isolate a driver from a drive cage. Applicant again notes that the “adapted” limitation must be considered as it recites a physical constraint rather than a mere intended use.

Lin’s fastener also is not “sized and configured to fit within a slot of the drive cage and to abut a surface of the drive cage”. Again, Lin’s fastener is not adapted for isolating a drive from a drive cage. Furthermore, nothing in Lin’s disclosure states that the Lin fastener is “sized and configured” to fit within a slot of a drive cage or to abut a surface of a drive cage. First, Applicant asserts that those limitations, as the “adapted” limitation discussed above, recites a physical constraint as opposed to a mere intended use. Second, the argument that Lin’s fastener is “capable” of fitting within a slot of a drive cage and abutting a drive cage surface does not equate to the fastener being “sized and configured for” such applications. Third, there is nothing in Lin’s disclosure that actually states that

Lin's fastener is in fact capable of fitting within a slot of a drive cage or abutting a drive cage surface.

In view of at least the above, Applicant respectfully submits that Lin does not anticipate claim 1 or its dependents and requests that the rejections be withdrawn.

### **III. Claim Rejections - 35 U.S.C. § 103(a)**

#### **A. Rejection of Claims 9-14, 17-20, 22-26, and 29**

Claims 9-14, 17-20, 22-26, and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Felcman, et al. ("Felcman," U.S. 6,122,173) in view of Grassens, et al. ("Grassens," U.S. Pat. No. 4,683,520). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

As is indicated above, independent claims 9 and 19 have been amended through this Response. In view of those amendments, Applicant respectfully submits that the rejections are moot as having been drawn against Applicant's claims in a previous form. Applicant discusses Applicant's claims and the applied references in the following, however, for the Examiner's consideration.

Applicant notes that there is no teaching or suggestion in the prior art to make the combination proposed in the Office Action or to modify the Felcman apparatus in the manner suggested in the Office Action. Felcman discloses inserting a floppy disk drive unit 40 along slots 54 of a computer 10 using cylindrical mounting screw heads 50. Felcman, column 2, lines 5-20. Felcman says nothing about isolation members or dampening vibrations. Grassens discloses a shock mount system that includes shock mounts 18 that are "integral with each sidewall" of a chassis 12 in which an electrical apparatus 10, such as an optical disk drive, is mounted. Grassens, column 2, lines 1-9. As is illustrated in Figure 2, the Grassens electrical apparatus rests upon grommets 40 within the chassis. In particular, the electrical apparatus is placed on the grommets and secured to the chassis using fasteners 48 that pass through the grommets. Grassens, column 2, lines 19-27.

As can be appreciated above, neither reference teaches or suggests using an isolation member as a member for sliding along a slot of a drive cage to guide a media drive along the drive cage while also isolating the media drive from the drive cage. Although it is true that Felcman teaches using screw heads as alignment members, and Grassens teaches using grommets to isolate electrical apparatus from an associated chassis, neither reference provides a teaching or suggestion to transform Felcman's screw heads into being or including grommets. Without such a teaching or suggestion, the rejection cannot be said to comprise a *prima facie* case of obviousness under 35 U.S.C. § 103. Given the lack of a suggestion or motivation contained in the prior art for the proposed modification, it appears clear that the only suggestion or motivation comes from Applicant's own disclosure. As is well established in the law, such hindsight to the Applicant's own disclosure is improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

Turning to the specific limitations of Applicant's independent claim 9, it is clear that neither Felcman nor Grassens teach a fastener including an isolation member including "a base portion having a first diameter and an outer wall that is adapted to abut a surface of the drive cage, and an axial portion that surrounds the shaft and extends from the base portion to the fastener head so as to be positioned between the base portion and the fastener head, the axial portion having a second diameter that is smaller than the first diameter". With particular regard to the Grassens disclosure, Grassens' grommet 40 comprises a simple cylindrical member having opposed end surfaces and a cylindrical



periphery that extends between the end surfaces. In addition to that grommet failing to include a separate “base” and “axial portion” that extends from the base, there would be no reason for a person having ordinary skill in the art to modify Grassens’ grommet to include such features because to do so would serve no purpose in Grassens’ shock mount system.

In summary, it is Applicant’s position that each of Applicant’s claims is patentable over Felcman/Grassens and that the rejections of the claims should be withdrawn.

#### **B. Rejection of Claims 15, 16, and 21**

Claims 15, 16, and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Felcman in view of Grassens and further in view of Lin, et al. (“Lin,” U.S. Pat. No. 6,917,520). Applicant respectfully traverses this rejection.

As is identified above, Felcman and Grassens do not teach several aspects of Applicant’s claims. In that Lin does not remedy the deficiencies of the Felcman and Grassens references, Applicant respectfully submits that claims 15, 16, and 21, which depend from claims 9 and 19, are allowable over the Felcman/Grassens/Lin combination for at least the same reasons that claims 9 and 19 are allowable over Felcman/Grassens.

#### **IV. Canceled Claims**

Claims 27-30 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

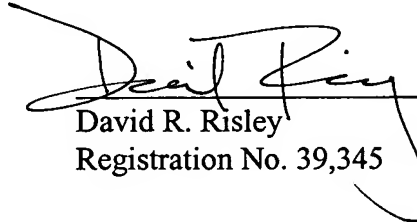
**V. New Claims**

Claim 32 has been added into the application through this Response. Applicant respectfully submits that this new claim describes an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that the claim be held to be allowable.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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